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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,787	01/26/2000	Andrew T Wilson	INTL-0317-US (P8000)	9051

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EXAMINER	
BOCCIO, VINCENT F	

ART UNIT	PAPER NUMBER
2615	9

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/491,787	WILSON ET AL.	
	Examiner	Art Unit	
	Vincent F. Boccio	2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION
Response to Arguments

1. Applicant's arguments filed 3/4/04 have been fully considered but they are not persuasive.

{A} In re page 8, "Applicants thank the examiner for the careful attention paid to the present matter",

further, "Applicants determined the claims do not claim storing of actual WEB content", conclusion, "retrieval and storage of web content is not anticipated or even suggested by Mankovitz".

In response, the examiner appreciates the grace provided, but, questions the understanding of applicant of what is determined to be inherent, by posing a question.

Can a system such as Mankovitz, retrieve WEB pages or WEB content and thereafter render the content without storage of that content (buffer or other), which is considered to be provided to the displayed, in a static form, for user viewing????

The answer to this question determines if the storage of the content is an inherent feature or not.

Since the WEB content is not provided in an actual broadcast as the video does it seemed that storage of the content would be or seems to be an inherent feature to thereafter be displayed.

Since, Mankovitz fails to particularly mention or disclose, the examiner had provided an alternate rejection under 103, the examiner believes to be a strong teaching with Butler, which provides a clear teaching of storage prior to rendering.

Claim Objections

2. Claims 28 and 30 are objected to because of the following informalities:

Regarding claims 28 and 30, with respect to independent claims 27 and 29, wherein the Independent claims recite,

"synchronization data between Video and WEB content" &

"synchronize video and WEB content",

wherein claims 28 and 30, recite, "determining the synchronization", using "time code",

"to synchronize video and enhanced content".

The examiner believes that claims 28 and 30, should recite "to synchronize video and ***associated WEB content***".

Appropriate correction/amendment or discussion/clarification, is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use

or on sale in this country, more than one year prior to the date of application for patent in the United States.

Or in an alternative view.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 1-2, 7-12, 17-25 are rejected under 35 U.S.C. 102(b) as anticipated by Mankovitz (WO 98/48566), or, in the alternative, under 35 U.S.C. 103(a) as obvious over Butler (US 2002/0007493).

Regarding claim 1, 11, and 21, Mankovitz discloses and meets the limitations associated with a method and apparatus comprising:

- receiving video and enhanced content (Fig. 4, "tuner", "PRI" and "Video"), ***including at least one ID of WEB content associated with the video*** (from the VBI, PRI, page 1, "World Wide Web, WWW", internet address, WEB pages, or web content);
- storing the video ("52") and the retrieved associated web content ("36")

- and the retrieved associated WEB content (the storage of WEB content based on the PRI and associated address, is considered to be inherent or even required to be rendered, it seems clear to the examiner that the WEB content must be inherently recorded/stored, to thereafter by rendered with the video, after the user selects the PRI, content is retrieved and considered to be inherently and required to stored for rendering with the video, as understood).

Since based on the argument presented, applicant does not see the requirement, or initially comprehend or come to a conclusion that the WEB content, based on a WEB address, is required to be stored to be rendered, or therefore, considered to be inherently stored to be rendered and further since Mankovitz is silent on this issue, the examiner cites Butler on an alternative 103 position.

Butler teaches providing enhanced content with broadcast video (TITLE), wherein according to Fig. 5, video is received with HTML and control files (230), which are from the WEB or internet and rendering HTML overlays (WEB content), with video, further teaches that the HTML from the internet can be provided in groups (page 4, col. 2,

"0047"-, "overlays can be provided in groups", "prior to the beginning of a … show"), (page 5, col. 2, "0060"-, "overlay files downloaded from an internet source"), as taught by Butler.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Mankovitz by storing the WEB content, prior to rendering or receiving the video to be rendered with overlays (HTML), associated with internet address information, to retrieve HTML overlay content from the internet, as taught by Butler, in order to receive the content, "prior to the time that they will be needed", and "taking data transmission speed into account", as stated by Butler page 5, col. 1, lines 3-6, as taught by Butler.

Claims 2, 7-10, 17-20, 21-25, since the claims have not been amended besides the amendment to the independent claims, the examiner incorporates by reference, the analysis from the last office action. VH

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 3, 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz (102) or Mankovitz and Butler (103), as applied above.

Claims 3, 13 and 26, the examiner since the claims have not been amended besides the amendment to the independent claims, is herein incorporated by reference by the examiner the rejection of these claims from the last office action.

4. Claims 4-6 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz (102) or Mankovitz and Butler (103), as applied above and further in view of Blackketter et al..

Claims 4-6, 14-16, since the claims have not been amended besides the amendment to the independent claims, the examiner incorporates by reference, the analysis from the last office action.

5. Claims 27-30, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz, as applied in above, in view of Butler.

Regarding claims 27-30, Mankovitz as applied above, discloses and meets the limitations associated with a method comprising:

- receiving video and enhanced content (video from the TUNER 11, content VBI and storage of the VBI content 36);
- retrieving the associated WEB content (page 1, "WWW … internet site address");
- storing the video ("52").

Mankovitz inherently performs synchronization of enhanced content by providing the PRI with the Video, as shown in Fig. 4 on the same screen, wherein the WEB content is retrieved based on the user selecting the PRI,

but, fails to particularly disclose or teach, synchronization of associated WEB content {with respect to claims 27 and 29} or determining synchronization data for subsequent synchronized playback of the video and the associated WEB content, wherein the synchronization comprises time code.

Butler teaches a system and meets the limitation of retrieving WEB content from the internet with required enhanced content including at least one ID of the WEB content,

Page 4, hyperlink overlays are retrieved (need an ID or address to retrieve from the WEB/internet, an address), in groups, from the internet, stored for later use to display the video stream in conjunction with the hyperlink overlays defined by the HTML files, wherein according to pages, 4-5, "A step 224 comprises associating the supplemental data files with the video stream. This step is performed by specifying control data such as timing parameters along with the video stream, indicating times of displaying hyperlink overlays in relation to the video stream. Note that the supplemental files are sent prior to the time that they will be needed, taking data transmission speed into account." Etc....., therefore, the timing parameters in combination with the control data, facilitate synchronization between the overlays and video, and suggest timing parameters, but, fails to particularly mention time code.

The examiner takes official notice that, "TIME CODE information", is known to be associated with video data.

Therefore, it would have been obvious to one skilled in the art, to modify the combination by storing the enhanced content and retrieved WEB content of Mankovitz and to synchronize the content (such as overlay content links) with the video, as taught by Butler, using conventional, time code data, as suggested by Butler, known to those skilled in the art, to facilitate the synchronization of the content and video, as is obvious would have been obvious to those skilled in the art.

In view of the objection to the claims above, it is noted {in view of making an attempt by the primary examiner to provide a higher level of clarity in this action}, that,

Butler also has possession of Enhanced Content Data, in order to retrieve overlay HTML files which are downloaded from an internet source (page 5, col. 2, for example).

Conclusion

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Fax Information

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231
or faxed to:
(703) 872-9314, (for formal communication intended for entry)
or:
(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Contact Information

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Andy Christensen (703) 308-9644.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vincent
5/17/04

VINCENT BOCCIO
PRIMARY EXAMINER